

REMARKS

Claims 5, 8, and 9 have been amended, and claim 7 has been canceled. Claims 1-6 and 8-13 are pending in the application.

Amendments to the specification add SEQ ID NO's where appropriate and replace the current Sequence Listing with a version that complies with the most recent rules.

Basis for the amendments to the claims are described in Applicant's communication of 17 May 2000. The only difference between the "once amended" claims 5, 8, and 9 of the 17 May 2000 communication and the "twice amended" claims 5, 8, and 9 of the present communication is to change the phrase "genomic DNA fragments" to "fragments of a target polynucleotide," which is expressly set forth in column 21, line 56-57, as well as numerous other locations in the section of the patent starting at column 21, line 54, and continuing on to column 23, line 38.

No new matter has been added by the amendments. Reconsideration is respectfully requested.

Sequence Listing

In response to the Examiner's request that the Sequence Listing be put into conformance with 37 CFR 1.821(e), Applicant has amended the specification to add SEQ ID NO's and a revised Sequence Listing and has submitted a computer readable form of the revised Sequence Listing. The revised Sequence Listing is being re-submitted herewith after making corrections in response to the Raw Sequence Listing Error Report dated 23 January 2001.

Rejection under 35 U.S.C. 112 Second Paragraph

In the final Office Action dated 16 August 2000, the Examiner rejected claims 5, 6, 8, and 9 under 35 USC 112, first paragraph, for containing subject matter not described in the specification. In particular, the Examiner averred that the phrase "genomic DNA fragments" did not have express support in the application. In response, Applicant submitted an amendment dated 4 January 2001 (not entered) which removed the term "genomic" from the above phrase in the appropriate claims. In the Advisory Action dated 24 January 2001, the Examiner expressed concern as to whether the phrase without "genomic" would sufficiently distinguish the description of Applicant's invention from the prior art represented by Dower, i.e. mixtures of combinatorially synthesized oligonucleotides on microbeads.

Applicant respectfully disagrees with the Examiner, particularly in view of the above amendments which have removed the adjective "genomic" and have replaced the term "DNA fragments" with "fragments of a target polynucleotide," which has express antecedent basis in the section of the specification subtitled "Parallel Sequencing" (column 21, line 53, to column 23, line 38).

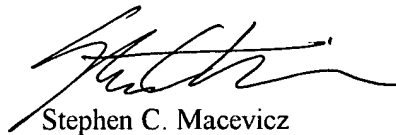
Applicant submits that the claims as now written overcome the Examiner's concern regarding whether Dower and like references are adequately distinguished. The term "fragments of a target polynucleotide" make it clear that the fragments are non-synthetic natural polynucleotides from an organism. This is further supported by Example II where the specification teaches the fragmentation of an SV40 genome and attachment of the fragments to microparticles for sequencing.

Accordingly, Applicant respectfully requests that the above rejection be withdrawn.

In view of the above, Applicants submit that the claims as written fully satisfy the requirements of Title 35 of the U.S. Code, and respectfully request that the rejections thereunder be withdrawn and the claims be allowed.

If any additional time extensions are required, such time extensions are hereby requested. If any additional fees not submitted with this response are required, please take such fees from deposit account 12-2491.

Respectfully submitted,



Stephen C. Macevicz
Reg. No. 30,285
Attorney for Applicants

Telephone: (510) 670-9365

Attachments:

Declaration of Sequence Listing
3.5 inch diskette containing computer readable form of Sequence Listing
Petition for Time Extension with Fee Authorization